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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/392,728 09/09/99 STOCKEMANN

K SCH-1550-C1

EXAMINER

HM22/1130

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ART UNIT

PAPER NUMBER

1617

DATE MAILED:

11/30/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/392,728

Applicant(s)

STOCKEMANN ET AL.

Examiner

Helen Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) 13, 14, 27, 28, and 33-46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 15-26, 29-32 and 47-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

DETAILED ACTION

Applicant's election with traverse of Group I, claims 1-32 and 47 to 49. In addition, Applicants elected species A(i)(2) and B(vi)(1), in Paper No. 5 is acknowledged. The traversal is on the ground(s) that a search of both combination and method claims would not place an additional burden on the examiner. This is not found persuasive because the record set forth in the previous restriction requirement clearly indicates that the delineated inventions are, in fact, patentably distinct, each from the other, and their different classification would necessitate additional searching.

The requirement is still deemed proper and is therefore made FINAL.

Claims 1-49 are pending.

Claims 13, 14, 27, 28, 33-46 are non-elected.

✓ Claims 1-12, 15-26, 29-32 and 47-49 are presented for examination.

The elected species are: A/ 11 β -(4-acetylphenyl)-17 β -hydroxy-17 α -(1-propenyl)estra-4, 9-dien-3-one. B/ Drospirenone (dihydrospirorenone).

Claim Objection

Claim 5 is objected to because of the following informalities:

✓ In claim 5, line 1 therein, the term "wherein" is misspelled.

Appropriate correction is required.

Said canceled BUT not clear from the Appl. B/c cl. 47 is still alive.
Claim 47 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 31. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of

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the allowed claim. See MPEP § 706.03(k). *Therefore, claim 47 has not been further examined.*

Claim Rejection

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10-12, and 24-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Explained by ✓
Appl.

In claims 12, 26, the term "another" is vague. It is non-limiting.

Admit ✓

In claims 10, 11, 24 and 25, the term "selected from" is indefinite. Do Applicants intend "the group consisting of after "selected from"? If so, the last member of the Markush group should be preceded by "and" not "or". Alternatively, Applicants can simply delete "selected from" to achieve a Markush group in the alternative form, where the last member is preceded by "or".

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-12, 15-26 are rejected under 35 U.S.C. 102(a) as being anticipated by Stockemann et al, DE 4344463A1 ('463). (See IDS of Feb. 09, 2000)

The Examiner adopts the rejection of the EPO Examiner over the claims in WO 97/06807 to the claims herein:

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Claims 1-12, 15-26 are not novel over the prior art ('463). See page 2, lines 61 to 68, page 3, lines 42 to 44, page 4, lines 1 to 19, page 5, lines 1 to 10, page 6, examples 1 to 3, claims 1, 3, 5, 6, 8, 9, 11 and 12.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 29, 31, 32 and 49 are rejected under 35 U.S.C. 102(a) as being anticipated by Anmelder, DE 4344405A1 ('405). (See IDS of Feb. 09, 2000)

Claims 29, 31, 32 and 49 are not novel over the prior art ('405). See column 1, lines 4 to 40, column 2, lines 30 to 35 and 55 to 64, and claim 1.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 30 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over ('405).

('405) teaches a contraceptive product to be taken sequentially. The subject matter of claims 30 and 48 is obvious to a person of ordinary skill in the art because claims 30 and 48 concern a slight structural change to claim 29, which a person skilled in the art is accustomed to make on the basis of routine considerations, especially as the advantages conferred are readily foreseeable.

No claims are allowed.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen Nguyen whose telephone number is (703) 605-1198. The examiner can normally be reached on Monday to Friday from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie, can be reached on (703) 308-4612. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Helen Nguyen
Patent Examiner
November 28, 2000

EDWARD J. WEBMAN
PRIMARY EXAMINER
GROUP 1500